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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/541,083

06/29/2005

Michael T. Carley

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EXAMINER

VELASQUEZ, VANESSA T

ART UNIT

PAPER NUMBER

1793

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/541,083	<b>Applicant(s)</b> CARLEY ET AL.	
	<b>Examiner</b> Vanessa Velasquez	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 is/are allowed.
- 6) ☒ Claim(s) 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>Oct. 12, 2007; Oct. 26, 2007; Jan. 24, 2008</u> .             | 6) <input type="checkbox"/> Other: _____                          |



## **DETAILED ACTION**

### ***Status of Claims***

Claims 1-16 remain examined.

### ***Status of Previous Objections***

The previous objections to the drawings are withdrawn in view of Applicant's amendments to the specification.

### ***Status of Previous Rejections***

The previous rejections of Claims 1 and 8 under the second paragraph of 35 U.S.C. 112 are withdrawn in view of Applicant's amendments to the claims.

Claim 13 stands rejected under the second paragraph of 35 U.S.C. 112 for lack of antecedent basis. Attention is drawn to the claim dependency of Claim 13. Claim 13 recites a compressing step, for which support is found in Claim 8. However, the Examiner wishes to point out that Claim 13 is dependent on **Claim 1**, in which there is no support for a compressing step.

The previous rejections of Claims 1-10 and 12-16 under 35 U.S.C. 103(a) as being unpatentable over Miura (US 5,092,941) in view of Peterson et al. (US 6,152,937) are withdrawn in view of Applicant's arguments. However, a new rejection has been applied to Claims 14-16.

The previous rejection of Claim 11 under 35 U.S.C. 103(a) as being unpatentable over Miura (US 5,092,941) in view of Peterson et al. (US 6,152,937) and further in view of Kleshinski et al. (US 5,540,712) is withdrawn in view of Applicant's arguments.

### ***Information Disclosure Statement***

Information disclosure statements (IDS) were submitted on Oct. 12, 2007; Oct. 26, 2007; and Jan. 24, 2008. The submissions are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

### ***Specification***

The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

### ***Claim Interpretation***

Claims 14-16 are product-by-process claims. Applicant is reminded that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

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unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

### ***Claim Rejections - 35 USC § 102/103***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 14-16 are rejected under 35 U.S.C. 102(a) or 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Carley et al. (US 2002/0188318 A1).

Regarding Claims 14-16, the claim is drawn to a clip product. US '318 teaches a clip (FIG. 1A) possessing a planar and annular structure with more than one tine (p. 1, para. [0011]). The clip may be made from a superelastic alloy such as Nitinol, which contains austenitic and martensitic phases. Therefore, US '318 anticipated the claimed clip.

In the alternative, Claims 14 and 16 are rejected under 35 U.S.C. 103(a). US '318 teaches a clip (FIG. 1A) possessing a planar and annular structure with more than one tine (p. 1, para. [0011]). The clip may be made from a superelastic alloy such as Nitinol, which contains austenitic and martensitic phases, the amounts of which can be

controlled by appropriate heat treatments to obtain a clip with a particular set of mechanical properties as so desired by the skilled artisan (p. 2, para. [0019-[0020]]).

The clip taught by US '318 is substantially similar to the claimed invention so as to be obvious to one of ordinary skill in the art.

Still regarding Claim 15, the claim is drawn to a clip product. US '318 teaches a clip (FIG. 1A) possessing a planar and annular structure with more than one tine (p. 1, para. [0011]). Primary tines may be of different lengths (p. 2, para. [0014]). US '318 further teaches that the tines of different lengths may point towards each other (p. 2, para. [0014]), as stated by the reference where the "first and second primary tines may be disposed on opposing curved regions, and may be oriented substantially towards each other in the planar configuration," thus describing a "radially opposed" configuration as claimed. The clip may be made from a superelastic alloy such as Nitinol, which contains austenitic and martensitic phases.

In the alternative, Claim 15 is rejected under 35 U.S.C. 103(a). US '318 teaches a clip (FIG. 1A) possessing a planar and annular structure with more than one tine (p. 1, para. [0011]). Primary tines may be of different lengths (p. 2, para. [0014]). US '318 further teaches that the tines of different lengths may point towards each other (p. 2, para. [0014]), as stated by the reference where the "first and second primary tines may be disposed on opposing curved regions, and may be oriented substantially towards each other in the planar configuration," thus describing a "radially opposed" configuration as claimed. The clip may be made from a superelastic alloy such as Nitinol, which contains austenitic and martensitic phases, the amounts of which can be



controlled by appropriate heat treatments to obtain a clip with a particular set of mechanical properties as so desired by the skilled artisan (p. 2, para. [0019-[0020]]).

The clip taught by US '318 is substantially similar to the claimed invention so as to be obvious to one of ordinary skill in the art.

### ***Allowable Subject Matter***

6. Claims 1-12 are allowed. The following is a statement of reasons for the indication of allowable subject matter: Peterson teaches forming an annular clip by machining a tube or sheet to form fingers, deflecting the fingers outward, and heat treating the clip in the shape of its final configuration. Miura teaches the austenitic transformation of nickel-titanium alloys. Peterson alone fails to teach or suggest the steps of providing a planar clip with outward-pointing tines, bending the tines such that they point inward toward the center of the clip, and quenching the clip so that it retains an inward configuration as claimed. Miura further fails to compensate for the deficiencies of the Peterson reference. Thus, the prior art of record does not teach or suggest the claimed invention.

### ***Response to Arguments***

Applicant's arguments (see p. 8, para. 2-3; p. 9, para. 1, 3, 4), filed Feb. 19, 2008, with respect to Claims 1-13 have been fully considered and are persuasive. Accordingly, the rejections of Claims 1-13 have been withdrawn.

Applicant's arguments (see p. 8, para. 2-3; p. 9, para. 1, 3, 4), filed Feb. 19, 2008, with respect to the rejections of Claims 14-16 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is made in view of Carley et al. (US 2002/0188318 A1).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanessa Velasquez whose telephone number is (571)270-3587. The examiner can normally be reached on Monday-Friday 8:30 AM-6:00 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached at 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/  
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